IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Ashley
Serial Number:	10/621,935
Filing Date:	July 17, 2003
Art Unit:	2132
Examiner:	Dinh, Minh
For:	**Method and system for automatic adjustment of entitlements in a distributed data processing environment**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

This paper is submitted in response to the office action mailed November 1, 2006. A one (1) month extension of time is submitted to extend the outstanding response deadline through March 1, 2007. Reconsideration and favorable action are respectfully requested for the reasons set forth below.

The Information Disclosure Statement

The Examiner's note regarding the Information Disclosure Statement filed on July 17, 2003, is acknowledged. The undersigned requests that the Examiner simply enter the reference as submitted previously and change the page description to match the actual pages submitted. There does not appear to be any reason to re-submit the pages, which the Office already has in its possession. If this proposed course of action is not acceptable, the Examiner is asked to provide an indication to that effect, in which case the reference will be re-submitted.

Alleged non-statutory subject matter

Claims 15-21 were rejected under 35 USC § 101 as directed to non-statutory subject matter because the "computer readable medium includes encoded signals." Respectfully, this rejection is traversed.

A "computer readable medium" type of claim does not become non-statutory because the medium may be realized using such signals. As stated in MPEP 2106 (IV)(B)(1):

> In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).
> (emphasis added)

The present invention as recited in independent claim 15 is clearly functional descriptive material as it imparts functionality when employed as a computer component.

The MPEP does not draw any distinctions between one type of media that is considered to be statutory and another type of media that is considered to be non-statutory. To the contrary, the MPEP clearly states that as long as the functional descriptive material is in "some" computer-readable medium, it should be considered statutory. The only exceptions to this are functional descriptive material that does not generate a useful, concrete and tangible result, e.g., functional descriptive material composed completely of pure mathematical concepts that provide no

practical result. The present invention, as recited in independent claim 15, provides a useful, concrete and tangible result in facilitating control over how an authorized user is permitted access to authorized and available resources in an operating environment. This is not just some disembodied mathematical concept or abstract idea.

Moreover, even if claim 15 covers encoded signals or transmission media, it is not the case that such signals and media are "intangible." The term "tangible" is not limited to elements that may be perceived only by the sense of touch. To the contrary, the term "tangible" refers to anything that is capable of being perceived, precisely identified or realized by the mind, or capable of being appraised at an actual or approximate value (Merriam-Webster Online Dictionary Definition). In other words, something is "tangible" if it is possible to verify its existence. This does not require that the element be "touchable" but merely "perceivable."

Encoded signals, carrier waves and other signal or transmission media are clearly perceivable, able to be precisely identified or realized by the mind, and are capable of being appraised. Computer readable media must be inherently "perceivable," otherwise it would not be "computer readable." In other words, encoded signals are measurable, readable, or usable by appropriate devices for measuring, reading or using such signals. Thus, they are "tangible." Because these types of media are "tangible," even if there were some requirement in the MPEP that the media be "tangible," the present claims would still meet this requirement and, thus, be directed to statutory subject matter.

The Board of Patent Appeals and Interferences, in *Ex Parte Carl A. Lundgren*, 2004 WL 3561262, Bd.Pat.App.&Interf., Apr 20, 2004, (No. APL 2003-2088, APP 08/093,516), has eliminated the Office's procedure of rejecting claims under 35 U.S.C. § 101 as being outside of the "technological arts." In other words, the Board has determined there is no requirement that the claims recite "technology" in order to be statutory. Because there is no requirement that "technology" be recited in the claims, as explicitly stated by the Board, there cannot be any requirement that a particular type of technology, e.g., computer readable media, be recited in the claims. As long as the claimed subject matter falls within the statutory classes of invention, i.e. a process, machine, manufacture, or composition of matter, that is all that is necessary for the claims to recite statutory subject matter.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 15-21 under 35 U.S.C. § 101.

Alleged anticipation

Claims 1-21 were rejected under 35 USC § 102(b) as being anticipated by Marks et al., U.S. Publication No. 2002/0010768. Respectfully, this rejection is traversed.

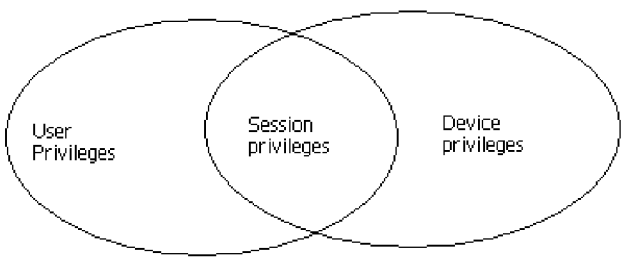
Marks et al. does describe a system that has similarities to the method and system of the present invention. Nevertheless, the claimed inventions here are distinguishable from Marks et al. is several important respects, as will now be described.

In general, the present invention concerns "a process for determining a set of resources to be shown to a user that are specifically authorized for the user and that have been specifically entitled for the user based on computational status information about the server-side environment." [0044]. An advantage of the invention is that it "proactively prevents users from obtaining an ability to request certain resources because of the state of the server-side system, even though the user would be authorized to request those resources under different server-side conditions; the user's entitled resources are always a subset of the user's normally authorized resources, although the set of entitled resources may be equal to or as extensive as the set of authorized resources." [0052].

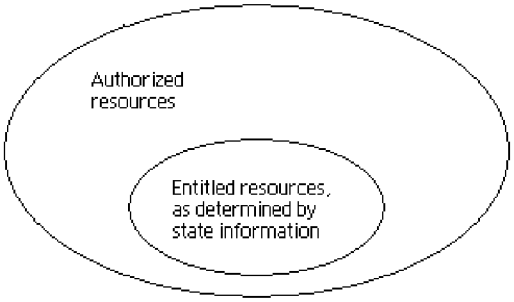
Marks et al. manage networked devices to allow tracking and dynamic generation of access privileges across multiple terminals and for multiple registered users. In their system, a user has a set of user privileges that is based on a user profile. The user profile includes the class of the user and a set of user privileges and settings (e.g., application licenses, bookmarks, file access privileges, network access privileges, page access privileges, and the like). The system also has available to it so-called "device privileges," which are obtained from an "asset database." A device privilege describes a terminal profile for a given terminal. The terminal profile includes a set of device privileges (e.g., applications available, network connections, and the like). [0047-48]. When an authorized user of the network logs in at a terminal, the user is provided with "session privileges" that are the intersection of the individual user privileges and the device privileges of the device on which the user is logged in. The "user has access to all resources that the user has rights to, so long as those resources are available (based both on

technical availability and usage policy) to the specific terminal being used regardless of the terminal being used and the location of the terminal." [0017].

The differences between the claimed invention and Marks et al. may be visualized as follows:



Marks et al.



Subject invention

As can be seen, in the present invention the resources actually exposed to the user (namely, the "entitled resources") are a function of the "state" (e.g., the current computational state) of those resources. Each of the subject claims emphasize this feature by requiring the explicit functions of "obtaining state information about the set of authorized resources" and "evaluating availability of the set of authorized resources based upon the state information …"

While Marks et al. make a passing reference to resources being "available (based both on technical availability and usage policy) to the specific terminal," this is not an explicit teaching of actively "obtaining state information," using such state information to evaluate availability of the user-authorized resources, or generating a "list of a set of entitled resources for the user." At most, Marks et al. know (from the terminal profile) the "applications available" or the "network connections" to that terminal. This static configuration appears to be the "technical availability" to which the inventors there refer; a preferred embodiment of the present invention, in contrast, is directed to techniques that are much more active and dynamic. Thus, for example, in a system like Marks et al., a session privilege might well provide the authorized user with access to an application running on the terminal that, in fact, is currently overloaded and cannot provide the required or expected quality of service to the user. In the subject invention, the "state" of that application would have been exposed to the system and, as a consequence, the application would have been omitted from the "set of entitled resources." The present invention thus provides a much more valuable end user experience (because the end user's expectations are not frustrated

when he or she tries to access a normally authorized resource that, for system or other reasons, is not then available to the authorized user).

The Manual of Patent Examining Procedure (MPEP) § 2131 provides that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. … 'The identical invention must be shown in as complete detail as contained in the … claim.' The elements must be arranged as required by the claim." (citations omitted, emphasis supplied). Marks et al. do not meet this rigid requirement because, as noted above, the reference does not disclose at least the following functions:

"obtaining state information about the set of authorized resources;"

"evaluating availability of the set of authorized resources based upon the state information about the set of authorized resources;" or

"generating a list of a set of entitled resources for the user in response to evaluating availability of the set of authorized resources."

For these reasons, the subject matter of claims 1 (method), 8 (apparatus) and 15 (computer program product) is not anticipated by Marks et al.

Dependent claims 2, 9 and 16 are each separately patentable because, in addition to not generating a list of entitled resources, Marks et al. do not disclose or suggest "sending an indication of the set of entitled resources to the user." Figure 5B illustrates an embodiment of this feature.

Dependent claims 3, 10 and 17 are each patentable for the reasons set forth above in connection with the respective parent independent claim.

Dependent claims 4, 11 and 18 are each separately patentable because Marks et al do not establish a list of entitled resources as described, nor does the reference describe the further step of "preventing the user from accessing resources that are in the set of authorized resources [but not within the set] of entitled resources." Indeed, as noted in the example above, Marks et al. might provide a "session privilege" for just this purpose.

Dependent claims 5, 12 and 19 are each patentable for the reasons set forth above in connection with the respective parent independent claim.

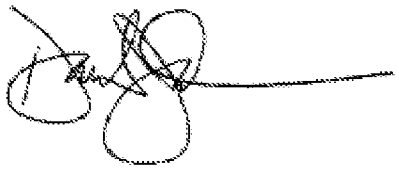
Dependent claims 6, 13 and 20 are each separately patentable because Marks et al. do not evaluate the "state" of any user-authorized resources, so they do not have any reason to (and, in fact, do not) use "a configurable rule" in connection therewith. There is nothing in Marks et al. that remotely discloses or suggests this particular claimed feature.

Likewise, dependent claims 7, 14 and 21 are each separately patentable because Marks et al. do not obtain "state information," let alone do so using a "distributed monitoring application."

For the above reasons, the anticipation rejection must be withdrawn.

A Notice of Allowance is requested.

Respectfully submitted,



By: _____

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